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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/678,363	09/29/2000	Philippe Vivarelli	99RSS340	4672
20594	7590	04/07/2005	EXAMINER	
AKIN GUMP STRAUSS HAUER & FELD, LLP P O BOX 688 DALLAS, TX 75313-0688			POKRZYWA, JOSEPH R	
			ART UNIT	PAPER NUMBER
			2622	

DATE MAILED: 04/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/678,363	VIVARELLI, PHILIPPE	
	<b>Examiner</b>	<b>Art Unit</b>	
	CHAN S PARK	2622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 20 August 2004.

2a) This action is **FINAL**.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-12 and 14-21 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-12 and 14-21 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date: _____
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date: _____	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____

## DETAILED ACTION

### ***Response to Amendment***

1. Applicant's amendment was received on 8/20/04, and has been entered and made of record. Currently, **claims 1-12 and 14-21** are pending.

### ***Response to Arguments***

2. Applicant's arguments, see pages 7-10, filed 8/20/04, with respect to the rejections of claims 1-12 and 14-21 under 35 U.S.C. § 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, new grounds of rejection is made in view of the Applicant's Admitted Prior Art (hereinafter Prior Art), wherein on pages 2-3 and fig. 1, and Joffe et al. U.S. Patent No. 6,801,341 (hereinafter Joffe) and Toyoda et al. U.S. Patent No. 6,330,070 (hereinafter Toyoda).
3. Examiner respectfully requests the applicant to provide a reference(s) that teaches the features disclosed in the Background of the Specification upon filing a response to the current Office action.

### ***Specification***

4. The disclosure is objected to because of the following informalities:  
Perhaps, a brief description of fig. 1 should be disclosed in the Brief Description of the Drawings.  
Appropriate correction is required.

***Claim Objections***

5. Claim 1 is objected to because of the following informalities:

Line 13, insert – and – after “provider;”

6. Claim 9 is objected to because of the following informalities:

Line 13, insert – and – before the last paragraph.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claim 9 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 9 recites that a first Internet service provider is not a fax gateway. This subject matter is not supported nor described in the original specification filed on 9/29/00.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 9-12, 14, 15, and 21 are rejected under 35 U.S.C. 102(a) as being anticipated by Prior art.

8. With respect to claim 9, the Prior art discloses a system for transmitting faxes (fig. 1), comprising:

a personal computer (client 150) having a modem that is compatible with a fax over Internet protocol client driver (FoIP 134) supporting a fax over Internet protocol session;

a first Internet service provider (ISP #1 130) that is not a fax gateway, the personal computer client connects in the first Internet service provider using the modem (fig. 1) and the fax over Internet protocol client driver (FoIP 134 and page 3, lines 1-3);

a second Internet service provider (ISP #2 135);

a fax machine communicatively coupled to the second Internet service provider (L4);

the personal computer client maintains a fax over Internet protocol session with the fax machine using the fax over Internet protocol client driver, and the personal computer client is not the first Internet service provider (fig. 1 and pages 2-3).

9. With respect to claim 10, the Prior art discloses the system of claim 9, wherein the personal computer client maintains at least one additional Internet protocol session over the connection with the first Internet service provider without switching between modes (fig. 1 and pages 2-3). The Office understands the system described in fig. 1 as the system that can send a plurality of facsimile data to Fax #2 or other facsimile machines in the network. Thus, it is concluded that each time the facsimile data is transmitted to the Fax #2 or the other facsimile machines, another Internet protocol session over the connection with the first Internet service provider is performed.

10. With respect to claim 11, the Prior art discloses the system of claim 9, wherein the Internet protocol network comprises the Internet (fig. 1).

11. With respect to claim 12, the Prior art discloses the system of claim 9, wherein the Internet protocol network comprises a private network that is operable using an Internet protocol (T38 protocol).

12. With respect to claim 14, the Prior art discloses the system of claim 9, wherein the fax over Internet protocol comprises a T38 protocol (page 2 and fig. 1).

13. With respect to claim 15, the Prior art discloses the system of claim 9, wherein the personal computer client connects to the first Internet service provider using a PSTN (fig. 1).

14. With respect to claim 21, the Prior art discloses the system of claim 9, wherein the modem supports data communication over one or more of the group comprising a public switched telephone connection, a digital subscriber line connection, and an integrated services digital network connection (fig. 1).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 6-8, 16, and 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Joffe in view of Toyoda.

15. With respect to claim 1, Joffe discloses a T38 driver system (fig. 2), comprising:

- a client (FAX 32) for requesting fax over Internet protocol session;
- a first Internet service provider (access server 40), the client connects to the first Internet service provider (fig. 2);
- a second Internet service provider (access server 62) that is operable to support a T38 protocol (col. 5, lines 33-46);
- an Internet protocol network (IP network 46), the first Internet service provider and the second Internet service provider are communicatively coupled via the Internet protocol network (fig. 2);
- a telephone network provider (PSTN 66);
- a fax machine (FAX 70) that is operable to be communicatively coupled to the second Internet service provider via the telephone network provider;
- a fax over Internet protocol session is maintained between the client and the fax machine via the first Internet service provider, the Internet protocol network, the second Internet service provider, and the telephone network provider (col. 4, lines 24-42);

the client maintains the fax over Internet protocol session with the fax machine using the T38 protocol client driver (col. 5, lines 33-46 & col. 6, lines 27-30).

Joffe, however, does not expressly teach that the T38 protocol driver is included in the client system.

Toyoda, the same field of endeavor of the Internet facsimile transmission (fig. 1), discloses an Internet facsimile (IFAX 11) comprising a Internet protocol client driver (Internet protocol driver is inherently included in IFAX 11 because it, by itself, directly transmits the facsimile data via the Internet) for sending facsimile data over Internet wherein said facsimile data is further transmitted to a destination facsimile machine (FAX 15) via PSTN (col. 2, lines 50-64).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to implement the Internet facsimile of Toyoda into the Internet facsimile system of Joffe.

The suggestion/motivation for doing so would have been to provide a facsimile machine that can send fax over Internet, using T38 Internet protocol session, to the destination facsimile machine.

Therefore, it would have been obvious to combine Joffe with Toyoda to obtain the invention as specified in claim 1.

16. With respect to claim 2, the combination of Joffe and Toyoda discloses the T38 client driver system of claim 1, wherein the client comprises a memory; and the T38 protocol driver is contained in the memory. As set forth above, the Internet facsimile of

Toyoda supports the fax over Internet protocol session with the destination fax. Thus, the driver is contained in the memory of the Internet facsimile.

17. With respect to claim 3, the combination of Joffe and Toyoda discloses the T38 client driver system of claim 1, wherein the Internet protocol network comprises a private network that is operable using an Internet protocol (col. 4, lines 27-62 of Toyoda and col. 5, lines 33-46).

18. With respect to claim 6, the combination of Joffe and Toyoda discloses the T38 client driver system of claim 1, wherein the client is operable to maintain at least one additional Internet protocol session. The Office understands the system described in fig. 1 of Toyoda as the system that can send a plurality of facsimile data to Fax 15 or other facsimile machines in the network. Thus, it is concluded that each time the facsimile data is transmitted to the Fax 15 or the other facsimile machines, another Internet protocol session over the connection with the first Internet service provider is performed.

19. With respect to claim 7, the combination of Joffe and Toyoda discloses the T38 client driver system of claim 1, wherein the client comprises a personal computer (PC12 in fig. 1). It, however, does not disclose expressly that the client comprises a laptop computer. Examiner takes Official Notice that using a laptop computer as a personal computer is well known in the art. The suggestion/motivation for using a laptop instead of a personal computer would have been to provide the user with a portable computer.

20. With respect to claim 8, the combination of Joffe and Toyoda discloses the T38 client driver system of claim 1, wherein the client comprises a modem having a

firmware; and the T38 protocol client driver is contained within the firmware (fig. 4 of Joffe and fig. 2 of Toyoda).

21. With respect to claim 16, arguments analogous to those presented for claim 1, are applicable.

22. With respect to claim 18, Toyoda discloses the client comprises at least one additional fax machine (IFAX 11) comprises an Internet capable fax machine (col. 2, lines 43-64).

23. With respect to claim 19, arguments analogous to those presented for claim 3, are applicable.

24. With respect to claim 20, arguments analogous to those presented for claim 6, are applicable.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Joffe and Toyoda as applied to claim 1 above, and further in view of Shibata U.S. Patent No. 6,825,955.

25. With respect to claim 4, the combination of Joffe and Toyoda discloses the T38 client driver system of claim 1, but it does not disclose expressly that the client connects to the first Internet service provider using an ISDN.

Shibata, the same field of endeavor of the Internet facsimile transmission, discloses Internet facsimile for transmitting facsimile data to the destination facsimile via the Internet wherein the transmitting Internet facsimile connects to the first Internet service provider (Internet service provider) using an ISDN (col. 6, lines 44-51).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to combine the facsimile transmission using the ISDN of Shibata with the Internet facsimile system of the combination of Joffe and Toyoda.

The suggestion/motivation for doing so would have been to provide a facsimile transmission system in the IDSN.

Therefore, it would have been obvious to combine the three references to obtain the invention specified in claim 4.

Claims 5 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Joffe and Toyoda as applied to claims 1 and 16 above, and further in view of Rabenko et al. U.S. Patent No. 6,765,931 (hereinafter Rabenko).

26. With respect to claim 5, the combination of Joffe and Toyoda discloses the T38 client driver system of claim 1, but it does not disclose expressly that the client connects to the first Internet service provider using an ADSL.

Rabenko, the same field of endeavor of the Internet facsimile transmission, discloses a facsimile that communicates via an ADSL (col. 9, lines 1-4).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to combine the facsimile transmission using the ADSL of Rabenko with the Internet facsimile system of the combination of Joffe and Toyoda.

The suggestion/motivation for doing so would have been to provide a facsimile transmission system in the ADSL.

Therefore, it would have been obvious to combine the three references to obtain the invention specified in claim 5.

27. With respect to claim 17, arguments analogous to those presented for claim 5, are applicable.

### ***Conclusion***

28. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHAN S PARK whose telephone number is (571) 272-7409. The examiner can normally be reached on M-F 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on (571) 272-7402. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

csp  
April 1, 2005

Chan S. Park  
Examiner  
Art Unit 2622

  
EDWARD COLES  
SUPERVISORY PATENT EXAMINER